



Attorney Docket 116.065

DAE  
IFW

**CERTIFICATE OF MAILING**

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Irving M. Fishman

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11/16/2006

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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NOV 22 2006

IN RE APPLICATION OF

Group Art Unit: 1625

OFFICE OF PETITIONS

BENNEKER, et al

Examiner: Chang

SERIAL NO: 09/200,743

FILED: November 30, 1998

FOR: 4-PHENYLPYPERIDINE COMPOUNDS

Mail Stop: Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Petition Under 37 CFR 1.182

to

Withdraw Previously Filed

Terminal Disclaimer

11/21/2006 AWONDAF1 00000036 09200743

01 FC:1462

400.00 OP

Sir:

Further to the above-identified application, Applicant respectfully requests that the Terminal Disclaimer dated January 31, 2001, be withdrawn and deemed of no effect in the present

application. If this is an improper section for obtaining the relief requested, Applicant respectfully requests that this paper be treated as a Petition under the appropriate provision and the enclosed fee applied as the fee required to such other provision.

According to Applicant's records, the original file in this case (parent application 08/872,023 had a restriction requirement and 09/200,743 (the present application) was filed as a division thereof. A Preliminary Amendment on 11/15/1998 limited the claims to subject matter that was not elected in the parent. Thus, no Terminal Disclaimer was needed at that time. In fact, the Action of 12/7/1999 did not mention any obviousness double patenting or need for any Terminal Disclaimer.

On 11/27/2000, Applicant replaced all of the claims with claims 30-39. Claims 30-38 were directed to non-elected subject matter in the parent case, but claim 39 was a species of the genus that was in the patent that issued from the parent case (US 5,874,447). Applicant, at this time, offered to file a Terminal Disclaimer due to the presence of claim 39, and a Terminal Disclaimer was executed on 1/31/2001 and filed.

On April 26, 2001, the Examiner required Restriction between Group I, claims 30-38, and Group II, claim 39. Applicant elected claims 30-38 and canceled claim 39. (Claim 39 had been refilled in a further application, Ser. No. 09/855,710.)

On August 2, 2001, the Examiner advised that claims 30-38 were allowable but for the suspension of the case for a potential Interference, an Interference which was concluded in Applicant's favor on May 25, 2004. The Application has, as of 11/16/2006, still not been returned to the examiner from the Board of Appeals and interferences, although Applicant has finally been advised that the Board of Appeals and Interferences is currently in the process of transferring the case back to the Examiner.

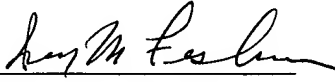
Since the need for the Terminal disclaimer was solely due only to the presence of claim 39, which subject matter has now been removed from the claims of the application, there is no longer

any basis for having the Terminal Disclaimer in the application, and Applicant respectfully requests that the Terminal Disclaimer be held withdrawn and/or be deemed a nullity.

Respectfully submitted,

Date: 11/16/, 2006

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PTO/SB/17p (09-08)

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# **PETITION FEE** **Under 37 CFR 1.17(f), (g) & (h)** **TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	09/200,743
Filing Date	November 30, 1998
First Named Inventor	Benneker
Art Unit	1625
Examiner Name	Chang, C.
Attorney Docket Number	116.065 (formerly 068540002-US01)

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NOV 22 2006

OFFICE OF PETITIONS

Enclosed is a petition filed under 37 1.182 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail

Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form

## **Payment of Fees** (small entity amounts are NOT available for petition fees)

☐ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. \_\_\_\_\_:

☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☐ any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

☒ Check in the amount of \$ 400.00 is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

## **Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

§ 1.36(a) - for revocation of a power of attorney by fewer than all applicants.

§ 1.53(e) - to accord a filing date.

§ 1.57(a) - to accord a filing date.

§ 1.182 - for decision on a question not specifically provided for.

§ 1.183 - to suspend the rules.

§ 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

## **Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

For petitions filed under:

§ 1.12 - for access to an assignment record.

§ 1.14 - for access to an application.

§ 1.47 - for filing by other than all the inventors or a person not the inventor.

§ 1.59 - for expungement of information.

§ 1.103(a) - to suspend action in an application.

§ 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.

§ 1.295 - for review of refusal to publish a statutory invention registration.

§ 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.

§ 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c) - for patent owner requests for extension of time in ex parte reexamination proceedings.

§ 1.956 - for patent owner requests for extension of time in inter partes reexamination proceedings.

§ 5.12 - for expedited handling of a foreign filing license.

§ 5.15 - for changing the scope of a license.

§ 5.25 - for retroactive license.

## **Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

§ 1.19(g) - to request documents in a form other than that provided in this part.

§ 1.84 - for accepting color drawings or photographs.

§ 1.91 - for entry of a model or exhibit.

§ 1.102(d) - to make an application special.

§ 1.138(c) - to expressly abandon an application to avoid publication.

§ 1.313 - to withdraw an application from issue.

§ 1.314 - to defer issuance of a patent.

*Irving M. Fishman*

Signature

Irving M. Fishman

Typed or printed name

11/16/2006

Date

30,258

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U. S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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